

REMARKS

I. Summary of Office Action

Claims 1 and 15 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter.

Claims 1-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginsberg U.S. Patent No. 6,754,639 ("Ginsberg").

Claims 57 and 58 were found to be directed to an invention that is independent or distinct from the invention originally claimed in claims 1-56. Claims 1-56 were constructively elected and claims 57 and 58 were withdrawn from consideration as being directed to a non-elected invention.

II. Summary of Reply to Office Action

Claims 1-3, 15-17, 29-31 and 43-45 have been amended. The claim amendments are fully supported and justified by the application as originally filed at, e.g., page 5, line 34 to page 6, line 19 and page 7, line 19 to page 8, line 12. Claims 57 and 58 have withdrawn from consideration as being directed to a non-elected invention.

The rejections under 35 U.S.C. § 101 and 35 U.S.C. § 103(a), based on Ginsberg, are respectfully traversed.

III. Summary of Telephonic Interview

Examiner Campen, the undersigned and undersigned's colleague Joel Weiss, Reg. No. 44,398, conducted a telephonic interview on November 30, 2005. The undersigned and Mr. Weiss (hereinafter "applicant's representatives") wish to thank

Examiner Campen (hereinafter "the Examiner") for the courtesies extended during the interview.

Details of the substance of the interview appear in more detail in the discussion below where appropriate. Generally, the Examiner and the applicant's representatives discussed whether "shifting [prices or sizes] of the selection of the plurality of bids or offers," which is specified in independent claims 1, 15, 29 and 43 is shown or suggested in Ginsberg. The Examiner and the applicant's representatives agreed that an amendment to the claims clarifying shifting prices or sizes would advance prosecution. In addition, in a separate telephonic interview on, or about, November 17, 2005, the Examiner and the undersigned discussed the rejection under 35 U.S.C. § 101 and the Examiner agreed to withdraw this rejection in view of the decision rendered since the issuance of the Office Action in Ex parte Lundgren, Appeal No. 2003-2088 (Precedential BPAI Opinion September 2005).

IV. Reply to Rejection under 35 U.S.C. § 101

Claims 1 and 15 were rejected under 35 U.S.C. § 101 for being directed to non-statutory subject matter (see Office Action, page 2). The rejection is respectfully traversed. As noted above, since the issuance of the Office Action dated August 25, 2005 that these remarks are responsive to, the Board of Patent Appeals and Interferences (hereinafter the "BPAI") issued Ex parte Lundgren, Appeal No. 2003-2088 (Precedential BPAI Opinion September 2005) (hereinafter "Lundgren"). The Lundgren decision established with further clarity patent eligible subject matter under § 101. As discussed with the

Examiner, this clarification by Lundgren renders the rejection under 35 U.S.C. § 101 moot in the above-identified patent application. Accordingly, applicant submits that claims 1 and 15 are directed to patentable subject matter as established by Lundgren and the rejection under 35 U.S.C. § 101 should be withdrawn.

V. Reply to Rejection under 35 U.S.C. § 103(a)

Claims 1-56 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ginsberg.

Applicant's independent claims 1, 15, 29 and 43 relate to shifting bids or offers in a trading system. Common to the independent claims is that a selection of a plurality of bids or offers in a trading system is received. In claims 1 and 29, prices of the selection of the plurality of bids or offers are shifted. The prices for each of the plurality of bids or offers in the selection are shifted by a percentage of the prices of each respective bid or offer of the selection. In claims 15 and 43, sizes of the selection of the plurality of bids or offers are shifted in response to the selection. The sizes for each of the plurality of bids or offers in the selection are shifted by a percentage of the sizes of each respective bid or offer of the selection.

The Office Action contended that independent claims 1, 15, 29 and 43 are obvious over Ginsberg. Applicant respectfully disagrees. Ginsberg is directed to a data processing system that receives transactional data related to fixed income securities (see Ginsberg, abstract). Using this data, indices for use in accurately gauging interest rate

profiles are determined in real time (see Ginsberg, column 1, lines 14-21). As pointed out in the October 8, 2004 Office Action*, Ginsberg discloses comparing bid prices and ask prices of different securities on the market. These comparisons illustrate possible shifts in market conditions and are used to determine which data, from that being accumulated, is reliable. (See October 8, 2004 Office Action, page 3; see also Ginsberg, column 6, line 34 to column 7, line 3).

The October 8, 2004 Office Action acknowledges though that Ginsberg does not disclose applicant's feature of shifting prices of the selection of the plurality of bids or offers, nor does it disclose applicant's feature of shifting sizes of the selection of the plurality of bids or offers** (see

* The present Office Action pointed to the October 8, 2004 Office Action for the "specific citations and reasoning" for the rejections under 35 U.S.C. § 103(a) (see August 25, 2005 Office Action, page 7). Where appropriate and necessary, specific citation to the particular Office Action referred to herein will be provided.

** The October 8, 2004 Office Action explicitly acknowledges only that Ginsberg does not disclose applicant's feature found in claims 1 and 29 of "shifting prices." The October 8, 2004 Office Action does not explicitly acknowledge that Ginsberg does not disclose applicant's feature found in claims 15 and 43 of "shifting sizes." However, the October 8, 2004 Office Action does explicitly substitute "size" for "price" in providing its reasoning elsewhere. (See October 8, 2004 Office Action, page 3 ("For claims 16-19, substitute "size" for "price" and refer to reasoning under 2-5 respectively.)) For the sake of advancing prosecution, applicant has assumed that the October 8, 2004 Office Action intended to acknowledge that the lack of disclosure applies to both shifting prices and shifting sizes.

October 8, 2004 Office Action, page 3). Applicant agrees and submits that while applicant's claims may generally implicate the subject matter of Ginsberg, applicant's approach patentably improves upon Ginsberg. In Ginsberg, the shifts for bid prices and ask prices reflect changing market conditions that are being monitored through the collection and comparison of data. Applicant's claims, however, require that the prices or the sizes of the selection of the plurality of bids or offers is shifted. Therefore, applicant's required claim feature reflects that the shifting is an active (or proactive) step being taken on the part of the trading system.

To further highlight the patentable distinction of applicant's claims, the claims have been amended to require that the prices or the sizes for each of the plurality of bids or offers in the selection are shifted by a percentage of the prices or sizes of each respective bid or offer of the selection. As noted above, in Ginsberg, the shifts in bid prices and ask prices are described as changes that reflect shifting market conditions. Applicant's amended claims patentably improve upon Ginsberg at least by requiring that the price or size of a selection of bids or offers are shifted (i.e., in an active step taken by the trading system) by a percentage of the price or size of each respective bid or offer of the selection.

Accordingly, for at least the foregoing reasons, applicant's independent claims 1, 15, 29 and 43 are allowable.

VI. Official Notice

The October 8, 2004 Office Action took Official Notice that the feature of shifting prices and shifting sizes is old and well known in the art. When replying to the October 8, 2004 Office Action, applicant traversed this Official Notice. The present Office Action contends that applicant's traversal of Official Notice was inadequate and that the "common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice or that the traverse was inadequate" (Office Action, page 7). Regardless, even if the features are well known (which applicant still submits is unclear), independent claims 1, 15, 29 and 43 include further patentable features, as described above, rendering applicant's claims patentable.

VII. Dependent Claims

Dependent claims 2-14, 16-28, 30-42 and 44-56 are dependent from at least one of allowable independent claims 1, 15, 29 and 43 and are allowable at least because independent claims 1, 15, 29 and 43 are allowable.

VIII. Conclusion

Accordingly, this application is in condition for allowance. Reconsideration and allowance of this application is respectfully requested.

Respectfully submitted,



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